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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,627	12/12/2001	Heiner Max	100718- 357/Beiersdorf 75	9248

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EXAMINER

KIM, VICKIE Y

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 04/21/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/021,627

Applicant(s)

MAX ET AL.

Examiner

Vickie Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application***

1. Acknowledgement is made of amendment filed on Jan. 16, 2003 wherein the request for cancellation of the original claims 1-8 has found and entered properly.
2. New claims 9-18 are added and presented for the examination. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

### ***Restriction/Election***

3. In previous office action, the original claims 1-8 were subjected to restriction requirement. As a result of restriction requirement, applicant elected group II, claims 5-8 which were drawn to a cosmetic preparation comprising di-and/or tetra-hydrofolic acid. The non-elected Group I, claims 1-4 which were directed to a method of preventing to DNA intrinsic to skin, were withdrawn from consideration and the examination were carried out based on the elected group I, claims 5-8.

Now, newly added claims 14-18 are directed to an invention that is independent or distinct from the invention of claims 9-13, which were originally elected for the reasons of the record (see paper No. 6). Among the newly added claims 9-18, the claims 14-18 which are directed to a method of effecting at least one result selected from the group consisting of preventing damage to DNA intrinsic using the di- and/or tetra-hydrofolic acid, are containing distinct invention from the claims 9-13 whose subject matter is drawn to the cosmetic preparation (composition).

Since applicant has received an action on the merits for the originally elected invention, the newly added claims 14-18 (method claims, originally non-elected) are

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again withdrawn from the consideration and the examination will be carried out based on the newly added claims 9-13(cosmetic preparation(composition claims), originally elected).

Thus, claims 9-18 are pending. the claims 9-13 are presented for the examination and the claims 14-18 are considered to be non-elected and will be withdrawn from the consideration.

***Claim Rejections - 35 USC § 112***

***New Matter***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the newly added claims 9-13, new limitation (i.e. in the absence of vitamin B12) is introduced. In the applicant's remarks, applicant states that ample support for adding new limitation(i.e. absence of vitamin B12) into the claims can be found throughout the specification wherein none of examples in the instant specification contain vitamin B12. However, applicant's support is not persuasive because the subject matter(i.e. absence of vitamin B12) **that was not possessed** by the inventor(s) at the time of the application was

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filed, and thus, it can not be excluded. Thus, the claims 9 and its dependent claims 10-13 are properly included in this new matter rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Spears et al(US 5,534,519).

US'519 teaches a topical composition for treating various skin conditions including benign keratoses, verrucae, or premalignant keratoses comprising tetrahydrofolic acid(FH4) in the form of 0.5% cream, see column 6, lines 1-2 and column 10, lines 58-67. It is noted that the preamble(cosmetic preparation) does not have patentable weight because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the present invention is directed to a preparation comprising 0.01-10% by weight of tetrahydrofolic acid. All the critical elements are taught by the cited reference. Thus, the claimed subject matter is not patentably distinguished over the prior art of the record and the all the claims 9-12 are properly included in this rejection.

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9. Claims 9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Danielov (US 5,885,974).

US'974 teaches a topical preparation comprising tetrahydrofolic acid, folic acid and vitamin E(tocopherol acetate, 0.15%) in the absence of vitamin B12, see example 17 at columns 54-55. Although the preamble(i.e. cosmetic preparation) does not have patentable weight, US'974 even teaches the cosmetic use of said preparation for treating various conditions of normal skin and scalp, see column 5, especially lines 53 and 66. Thus, all the critical elements required by the instant claims are met by the cited reference and the claimed subject matter is not patentably distinguished. All the claims are properly included in this rejection.

### ***Conclusion***

10. No claim is allowed.

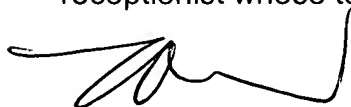
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 703-305-1675. The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 703-308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-3165 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Vickie Kim,  
Patent examiner  
April 17, 2003  
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